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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,128	07/29/2003	Joseph M. Asher	CF-84	5903
64558 7590 02/05/2007 FISH & NEAVE IP GROUP ROPES & GRAY LLP 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704			EXAMINER HAQ, NAEEM U	
			ART UNIT 3625	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	02/05/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/629,128	ASHER ET AL
	Examiner	Art Unit
	Naeem Haq	3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 15 November 2006.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-100 is/are pending in the application.  
 4a) Of the above claim(s) 2-18,23-33,48-71,77-85 and 99 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,19-22,34-47,72-76,86-98 and 100 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 7/29/03.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to the Applicants' amendment filed on November 15, 2006. Claims 1-100 are pending. Claims 2-18, 23-33, 48-71, 77-85, and 99 were withdrawn in a previous office action and remain withdrawn. Claims 1, 19-22, 34-47, 72-76, 86-98, and 100 will be considered for examination.

Applicants' amendment to claims 40 and 92 are sufficient to overcome the rejection of these claims under 35 U.S.C. 112, second paragraph. This rejection is withdrawn for claims 40 and 92.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 72 rejected under 35 U.S.C. 112, first paragraph; as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This claim recite the limitation "...after the announcement of the current bid." There is no support for this limitation in the originally filed specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 36, 37-45, 39, 88, 89-98 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claims 36, 37, 88, 89: These claims recite a conditional statement (i.e. "if"). It is unclear to the examiner what the metes and bounds of the claims are when the conditional statement is false. The claims fail to clearly set forth the scope because the claims do not recite what happens when the conditional statement is false.

Referring to claim 39 and 91: These claims recite the word "substantially". This term is a relative term which renders the claim indefinite because the term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

#### *Final Rejection*

#### *Claim Rejections - 35 USC § 103*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1, 19-22, 34, 35, 47, 73, 74, 75, 76, 86, 87, and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melkomian et al. (US 2002/0128952 A1)(“Melk”) in view of Gottsman et al. (US 6,134,548)(“Gottsman”).**

Referring to claims 1, 35, 46, and 100: Melk teaches an apparatus for implementing an automated auction process, comprising:

- a memory operable to: store data regarding a plurality of animated characters (paragraphs [0063], [0152], claim 7);
- a processor communicatively coupled to a memory and to plurality of workstations, wherein a first workstation is associated with a first user and the processor is operable to:
  - cause the first workstation to display a first animated character as an animated auctioneer operable to announce a current bid for an item (paragraphs [0063], [0070], [0155], and Abstract);
  - receive one or more bids from at least one workstation (Abstract; paragraph [0063]);
  - determine a winning bid based at least in part on the one or more received bids (paragraphs [0112] and [0113]).

Melk does not teach storing a profile associated with a first user, or determining a first animated character based at least in part on the profile associated with the first user. However, Gottsman teaches displaying an agent (i.e. animated character) to a user based on a user's profile (col. 34, lines 28-43; col. 39, lines 16-21). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Gottsman into the invention of Melk. One of ordinary

skill in the art would have been motivated to do so in order to personalize the animated character.

Referring to claim 19: The cited prior art teaches all the limitations of claim 1 as noted above. Furthermore, Gottsman teaches determining a second animated character, from a plurality of animated characters, based at least in part on the profile associated with the first user and displaying the character as an animated spotter operable to solicit a request from the first user (Figure 22, "2200"; col. 34, lines 28-66; col. 39, lines 16-35). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Gottsman into the invention of Melk. One of ordinary skill in the art would have been motivated to do so in order to allow a user to personalize the animated character for different environments.

Referring to claim 21: The cited prior art teaches all the limitations of claim 1 as noted above. Furthermore, Melk teaches that the animated character seeks confirmation from the first user for a bid placed by the first user (paragraphs [0068] and [0136]).

Referring to claim 22: The cited prior art teaches all the limitations of claim 1 as noted above. Furthermore, Melk teaches that the animated character is adapted to announce to the user the bid placed by the first user (paragraph [0070]).

Referring to claim 34: The cited prior art teaches all the limitations of claim 1 as noted above. The cited prior art does not teach that the animated character represents a celebrity. However, the Examiner notes that this limitation is not functionally or

structurally involved in the elements of the recited system. Therefore this limitation is deemed to be nonfunctional descriptive material. The elements of apparatus would be the same regardless of what the animated character represented. The difference between the Applicants' invention and the prior art is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the animated character (i.e. avatar) of the cited prior art represent any type personality (e.g. a celebrity) because such representation does not functionally structurally relate to the elements of the claimed apparatus and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claim 73: Claim 73 is rejected under the same rationale as set forth above in claim 19.

Referring to claim 75: Claim 75 is rejected under the same rationale as set forth above in claim 21.

Referring to claim 76: Claim 76 is rejected under the same rationale as set forth above in claim 22.

Referring to claim 86: Claim 86 is rejected under the same rationale as set forth above in claim 34.

Referring to claim 87: Claim 87 is rejected under the same rationale as set forth above in claim 35.

Referring to claims 20, 47, and 74: Claims 20, 47, and 74 are rejected under the same rationale as set forth above in claim 1.

### ***Response to Arguments***

Applicants' arguments with respect to the art rejection have been considered but are moot in view of the new ground(s) of rejection.

Applicants' arguments with respect to the rejection of claims 39 and 91 have been fully considered but they are not persuasive. The Applicants have alleged that Figure 4 and paragraphs 71-74 define the term "substantially" to one of ordinary skill in the art. The examiner respectfully disagrees. No definition is provided in these sections of the specification or drawings.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Naeem Haq, Primary Examiner  
Art Unit 3625

January 31, 2007